

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	§	Group Art Unit: 3672
Costa, et al.	§	
	§	Examiner: Unknown
Serial No. 10/522,039	§	
	§	
Filed: January 19, 2005	§	Confirmation No. : 1547

For: PROTECTIVE SLEEVE FOR THREADED CONNECTIONS FOR EXPANDABLE LINER HANGER

**MAIL STOP PCT**

Bryan Lin  
PCT Legal Examiner  
PCT Legal Office  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

I hereby certify that this correspondence is being filed with the United States Patent and Trademark Office via EFS-Web on the following date.

Date

August 27, 2007

Ellen Lovelace

Ellen Lovelace

Sir:

**PETITION UNDER 37 C.F.R. § 1.182**

Applicants refer to a telephone conference on February 22, 2007 between Attorney Advisor Richard Ross and Charles E. Van Horn who is also engaged to represent applicants in this matter as indicated by the attached Authorization to Act in a Representative Capacity (Attachment A). During that telephone conference, Mr. Van Horn explained that this is one of several applications in which essentially the same procedures were followed to reduce the number of claims presented for examination in the National Stage application. Although the procedures found defective in this application were found acceptable by the U.S. Patent and Trademark Office (PTO) in other applications, applicants want to ensure that all applications are processed

correctly and that any errors are corrected with minimal expense and inconvenience to both applicants and the PTO.

It was agreed with Mr. Ross, and subsequently with his successor, PCT Legal Examiner Bryan Lin, that applicants would seek an appropriate basis for relief in one of the affected applications, namely U.S. Patent Application No. 10/548,934, so that it could be used as a template for action in the other affected applications. Attached is a copy of the Decision on the Renewed Petition for Refund Under 37 CFR 1.26 that was treated as a Petition Under 37 CFR § 1.182 (Attachment B). As noted in the Decision, the Petition Under 37 CFR § 1.182 was granted and a refund of \$28,650.00 was deposited in Deposit Account No. 08-1394.

### **BACKGROUND**

On June 24, 2003, applicants filed International Application No. PCT/US2003/019993 containing 253 claims, which claimed the priority of United States Patent Application No. 60/397,284 filed July 19, 2002. The thirty month period for paying the basic national fee in the United States expired on January 19, 2005.

On January 19, 2005, applicants filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1) and a substitute specification attempting to reduce the number of claims from 253 to 166. On January 20, 2006, applicants filed a Preliminary Amendment, and on March 10, 2006, applicants filed a Response to Notification of Missing Requirements, both of which included an

authorization to charge any fees which may be required to applicants' representative's Deposit Account No. 08-1394.

On April 18, 2006, applicants' representative's Deposit Account No. 08-1394 was debited for excess claim fees in the amount of \$18,250.00 based upon the number of claims in the international application.

Applicants file the present Petition Under 37 CFR § 1.182 to waive the requirement that a preliminary amendment must accompany the initial national stage papers in order to reduce the number of claims to be considered in calculating extra claim fees.

### DISCUSSION

37 CFR § 1.26(a) states in relevant part,

The Commissioner may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent or trademark filing for which the fee was paid, including an application, an appeal, or a request for an oral hearing, will not entitle a party to a refund of such fee.

A review of international application PCT/US2003/019993 reveals that the application contained 253 claims. A proper amendment reducing the number of claims was never submitted in the international application.

MPEP § 1893.01(c) states in relevant part,

A preliminary amendment accompanying the initial national stage submission under 35 U.S.C. § 371 that cancels claims and/or eliminates multiple dependent claims will be effective to reduce the number of claims to be considered in calculating extra claim fees required under 37 CFR § 1.492(d)-(e) and/or eliminate the multiple dependent claim fee required under 37 CFR § 1.492(f). A subsequently filed amendment canceling claims and/or eliminating multiple dependent claims will not entitle applicant to a refund of fees previously paid. See MPEP § 607 and § 608. (Emphasis added.)

In the present case, the initial national stage submission on January 19, 2005 did not include a proper preliminary amendment.

It is respectfully submitted, however, that it is apparent from the papers filed January 19, 2005 that applicants sought to reduce the number of claims for examination at the time of national stage entry. Specifically, the substitute specification contained a listing of 166 claims, rather than the 253 claims contained in the international application. Furthermore, a preliminary amendment was filed on January 26, 2006, which sought to reduce the total number of claims to 166, but was improperly formatted with renumbered claims. Therefore, Applicants request that the Preliminary Amendment filed January 26, 2006 be withdrawn in favor of the Second Preliminary Amendment filed herewith which is consistent with the claims contained in the substitute specification and which reduces the number of claims in this application to 166. Because of applicants' intent to reduce the number of claims for examination and because the fees paid towards the examination of claims are not remotely commensurate with the number of claims that remain for examination, applicants submit that justice in the present case requires waiver of the requirement that a preliminary amendment must accompany the initial national stage papers in order to reduce the number of claims to be considered in calculating extra claim fees.

#### **REQUESTED RELIEF**

Accordingly, it is requested that the claim fees paid based on the presence of the original 253 claims, less the claim fees based on the remaining 166 claims, be deemed to be in excess of that required, and that refund of such excess under 37 CFR § 1.26(a) is appropriate.

A review of the fee records for the present application reveals that \$18,250.00 has been paid for excess claim fees. The application currently contains 166 total claims, including 23 independent claims. Thus, an extra claims fee of \$11,300.00 is required which is comprised of a fee of \$7,300.00 for 146 claims in excess of 20, and a fee of \$4,000.00 for 20 independent claims in excess of 3. Consequently, it is requested that a total of \$6,950.00 be refunded to Deposit Account No. 08-1394.

### **CONCLUSION**

The Commissioner is hereby authorized to charge payment of any fees associated with this Petition, including the fee due under 37 CFR § 1.17(f), or to credit any overpayment to Deposit Account No. 08-1394, Order No. 25791.106.05.

Prompt and favorable consideration of this petition and application are respectfully requested. If any additional information is needed or desired, please contact the undersigned at your convenience.

Respectfully submitted,

HAYNES AND BOONE, L.L.P.

Dated: 27 August 2007

By: 

Randall C. Brown  
Reg. No. 31,213

Telephone: 214-651-5242  
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Attachments A and B

# ATTACHMENT A

PTO/SB/84 (09-06)

Approved for use through 12/31/2008 OMB 0651-0035

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

## AUTHORIZATION TO ACT IN A REPRESENTATIVE CAPACITY

In re Application of: Costa, et al.

Application No. 10/522,039

Filed: January 19, 2005

Title: Protective Sleeve For Threaded Connections For Expandable Liner

Attorney Docket No. 25791.106.05

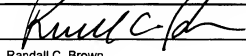
Art Unit: 3672

The practitioner named below is authorized to conduct interviews and has the authority to bind the principal concerned. (Note: pursuant to 37 CFR 10.57(c), a practitioner cannot authorize other registered practitioners to conduct interviews without consent of the client after full disclosure.) Furthermore, the practitioner is authorized to file correspondence in the above-identified application pursuant to 37 CFR 1.34:

Name	Registration Number
Charles E. Van Horn	40,266

This is not a Power of Attorney to the above-named practitioner. Accordingly, the practitioner named above does not have authority to sign a request to change the correspondence address, a request for an express abandonment, a disclaimer, a power of attorney, or other document requiring the signature of the applicant, assignee of the entire interest or an attorney of record. If appropriate, a separate Power of Attorney to the above-named practitioner should be executed and filed in the United States Patent and Trademark Office.

### SIGNATURE of Practitioner of Record

Signature		Date	2/16/07
Name	Randall C. Brown	Registration No., if applicable	31,213
Telephone	(214) 651-5242		

This collection of information is required by 1.31, 1.32 and 1.34. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 3 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



11 JUN 2007

## ATTACHMENT B

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
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P.O. BOX 1450  
ALEXANDRIA, VA 22313-1450  
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HAYNES AND BOONE, LLP  
901 MAIN STREET  
SUITE 3100  
DALLAS, TX 75202-3789

In re Application of WATSON et al	:	
U.S. Application No.: 10/548,934	:	
PCT Application No.: PCT/US2004/007711	:	
Int. Filing Date: 11 March 2004	:	
Priority Date Claimed: 11 March 2003	:	DECISION
Attorney Docket No.: 25791.253.05	:	
For: APPARATUS FOR RADIALY	:	
EXPANDING AND PLASTICALLY	:	
DEFORMING A TUBULAR MEMBER	:	

This is in response to applicant's "Renewed Petition for Refund Under 37 CFR 1.26" filed 27 November 2006 and "Supplemental Renewed Petition for Refund Under 37 C.F.R. § 1.26" filed 13 March 2007, which are being treated together as a petition under 37 CFR 1.182 as authorized by applicant. The requisite \$400.00 petition fee will be charged to Deposit Account No. 08-1394 as authorized in the petition.

**BACKGROUND**

On 11 March 2004, applicant filed international application PCT/US2004/007711, which claimed priority of an earlier United States application filed 11 March 2003. The thirty-month period for paying the basic national fee in the United States expired on 12 September 2005 (11 September 2005 was a Sunday).

On 12 September 2005, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1), a substitute specification, and an authorization to charge any fees which may be required to a deposit account.

On 14 June 2006, applicant's deposit account was debited for excess claim fees.

On 30 June 2006, applicant filed a request for refund under 37 CFR 1.26.

On 26 September 2006, this Office mailed a decision dismissing the 30 June 2006 request for refund.

On 27 November 2006, applicant filed the present renewed request for refund under 37 CFR 1.26.

On 13 March 2007, applicant filed the present supplemental renewed request for refund under 37 CFR 1.26.

### DISCUSSION

37 CFR 1.26(a) states in relevant part,

The Commissioner may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent or trademark filing for which the fee was paid, including an application, an appeal, or a request for an oral hearing, will not entitle a party to a refund of such fee.

A review of international application PCT/US2004/0007711 reveals that the application contained 520 claims. A proper amendment reducing the number of claims was never submitted in the international application.

MPEP 1893.01(c) states in relevant part,

A preliminary amendment accompanying the initial national stage submission under 35 U.S.C. 371 that cancels claims and/or eliminates multiple dependent claims will be effective to reduce the number of claims to be considered in calculating extra claim fees required under 37 CFR 1.492\*\*>(d)-(e)< and/or eliminate the multiple dependent claim fee required under 37 CFR 1.492\*>(f)<. A subsequently filed amendment canceling claims and/or eliminating multiple dependent claims will not entitle applicant to a refund of fees previously paid. See MPEP § 607 and § 608, (Emphasis added.)

In the present case, the initial national stage submission on 12 September 2005 did not include a proper preliminary amendment. The petition states that the presentation of claims contained in the substitute specification should have been treated as an improperly formatted amendment, and that applicant should have been given an opportunity to file a corrected preliminary amendment in accordance with MPEP 714.01(e). Even assuming *arguendo* that applicant should be allowed to submit a corrected preliminary amendment, any corrected amendment would not have accompanied the initial national stage submission and thus would not be effective to reduce the number of claims to be considered in calculating extra claim fees in accordance with MPEP 1893.01(c). Therefore, the corrected amendment would not entitle applicant to a refund of the extra claim fees previously paid.

However, it is apparent from the papers filed 12 September 2006 that applicant sought to reduce the number of claims for examination at the time of national stage entry. Specifically, the substitute specification contained a listing of 67 claims, rather than the 520 claims contained in



the international application. Furthermore, the transmittal letter (Form PTO-1390) contained a payment calculation based on the presence of 67 claims as opposed to 520 claims. A proper preliminary amendment was filed on 13 March 2007, reducing the total number of claims to 67. Because of applicant's intent to reduce the number of claims for examination and because the fees paid towards the examination of claims are not remotely commensurate with number of claims that remain for examination, justice in the present case requires waiver of the requirement that a preliminary amendment must accompany the initial national stage papers in order to reduce the number of claims to be considered in calculating extra claim fees. Accordingly, the claim fees paid based on the presence of the original 520 claims, less the claim fees based on the remaining 67 claims, are deemed to be in excess of that required, and refund of such excess under 37 CFR 1.26(a) is appropriate.

A review of the fee records for the present application reveals that \$33,600.00 has been paid for excess claim fees. The application currently contains 67 total claims, including 16 independent claims. Thus, a fee of \$2,350.00 for 47 claims in excess of 20 is required, and a fee of \$2,600.00 for 13 independent claims in excess of 3 is required. A total of \$28,650.00 will be refunded to Deposit Account No. 08-1394.

### CONCLUSION

For the reasons above, the petition under 37 CFR 1.182 is GRANTED.

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for processing in accordance with this decision and will be forwarded to Technology Center AU 3676 for examination in due course.

*Bryan Lin*

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PCT Legal Office

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06/12/2007 SBASHEIR 00000001 001394 10548934  
01 FC:1614 200.00 DA

Adjustment Date: 06/12/2007 SBASHEIR  
06/14/2006 EVANS 00000001 001394 10548934  
02 FC:1614 6200.00 CR

Adjustment Date: 06/12/2007 SBASHEIR  
06/14/2006 EVANS 00000001 001394 10548934  
01 FC:1615 22650.00 CR